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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/281,474	03/30/1999	MILIND RAJOPADHYE	DM-6958	7274

46339 7590 05/25/2005

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EXAMINER
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JONES, DAMERON LEVEST

ART UNIT	PAPER NUMBER
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1618

DATE MAILED: 05/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/281,474

Applicant(s)

RAJOPADHYE ET AL.

Examiner

D. L. Jones

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 February 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-10, 12-35, 48-50, 52 and 53 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10, 12-35, 48-50, 52, and 53 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **ACKNOWLEDGMENTS**

1. The Examiner acknowledges receipt of the amendment filed 2/18/05 wherein claims 11, 36-47, and 51 are canceled and claim 53 is added.

**Note:** Claims 1-10, 12-35, 48-50, 52, and 53 are pending.

## **RESPONSE TO APPLICANT'S AMENDMENT/ARGUMENTS**

2. The Applicant's arguments/amendment filed 2/18/05 to the rejection of claims 1-10, 12-35, 48-50, and 52 made by the Examiner under 35 USC 103 and/or double patenting have been fully considered and deemed non-persuasive for reasons of record in the office action mailed 11/18/04 and those set forth below.

### **Double Patenting Rejections**

The provisional rejection of claims 1-10, 12-35, 48-50, 52, and newly added 53 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over copending application numbers 09/465,300; 09/466,582; 09/599,364; 09/281,209; and 09/948,807 are MAINTAINED for reasons of record in the office action mailed 11/18/04 and those set forth below.

**Note:** It is once again duly noted that Applicant intends to rebut the double patenting rejections once all other rejections are withdrawn.

### **103 Rejection**

The rejection of claims 1, 2, 12-15, 17, 19-21, 25, 27, 28, 31-35, 48-50, 52, and newly added 53 under 35 USC 103(a) as being unpatentable over Palladino et al (US

Patent No. 5,780,426) in view of Sharma (US Patent No. 6,331,285) is MAINTAINED for reasons of record in the office action mailed 11/18/04 and those set forth below.

In summary, Applicant asserts that all of the independent claims have the limitation of a compound having a targeting moiety that is 'bound to' the chelator. However, the Examiner has not shown a targeting moiety bound to the chelator. Furthermore, Applicant asserts that based on the teachings of the prior art, there is no clear motivation or suggestion that the specific targeting moiety may be bound to a chelator. Furthermore, Applicant asserts that the Examiner has not addressed how the cited prior art may be modified to arrive at the specific compounds listed in dependent claims 6, 16, 18, 22, 24, 26, and 30.

In Palladino et al, it is disclosed that that the peptides may be labeled using various methods of labeling known in the art which includes using metal binding domains. In addition, Palladino et al disclose that the labels may be attached by a spacer arm of varying length (column 6, lines 37-55; columns 20-21, bridging paragraph). Since, Sharma discloses techniques used in the art to radiolabel peptides, the references may be considered to be within the same field of endeavor; thus, the references are combinable. For example, Sharma discloses that the spacer sequences may be incorporated into the peptide constructs (column 28, lines 23-45). Also, a chelating moiety may be incorporated into (i.e., bound to) the peptide (column 37, lines 35-45; and column 39, lines 50-60). Thus, the chelator is bound to the peptide.

In regards to Applicant's comments that the Examiner has not shown how the cited prior art may be modified to arrive at the specific compounds of claims 6, 16, 18,

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22, 24, 26, and 30, it should be noted that claims 6, 16, 18, 24, 26, and 30 were not cited in the rejection of Palladino et al in view of Sharma. As for claim 22, it should also have been excluded from the 103(a) rejection.

### COMMENTS/NOTES

3. It should be noted that prior art has not been cited against all of Applicant's claims. In particular, those claims are distinguished over the prior art of record because the prior art neither anticipates nor renders obvious the additional limitations present in those dependent claims in combination with the limitations of their respective intervening claims.


4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. L. Jones whose telephone number is (571) 272-0617. The examiner can normally be reached on Mon.-Fri., 6:45 a.m. - 3:15 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman Page can be reached on (571) 272-0602. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
D. L. Jones  
Primary Examiner  
Art Unit 1616

May 19, 2005